P20465.A04

#1 5/22/02 RECD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : DR. Ing Lothar ZIMMERMANN

Group Art Unit: 3726

Serial No : 09/759,171

Examiner: M.C. Jimenez

Filed : January 16, 2001

For : ELASTIC ROLL, PROCESS FOR PRODUCING SUCH A ROLL, AND PROCESS OF REPAIRING THE ROLL

ELECTION WITH TRAVERSE

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Examiner's restriction requirement of April 23, 2002, the time set for response being one month from the mailing date from the U.S. Patent and Trademark Office, i.e., May 23, 2002, Applicant hereby elects the invention of Group I, including claims 1-23 and 47. The above election is made with traverse for the reasons set herein below.

In the Official Action of April 23, 2002, the Examiner indicated that all claims (1-51) were subject to restriction under 35 U.S.C. § 121. The Examiner indicated that the inventions were patentably distinct and were restrictable as between the invention of Group I, including claims 1-23 and 47, drawn to roll, classified in class 492, subclass 30, Group II, including claims 24-39 and 48, drawn to a process of making a roll, classified in class 29, subclass 895.211 and Group III, including claims 40-46 and 49-51, drawn to a process of repairing a roll, classified in class 29, subclass 895.1.

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Attorney Docket No. P20465

In re application of : Dr. Ing Lothar ZIMMERMANN

Serial No. : 09/759,171 Group Art Unit: 3726

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For : ELASTIC ROLL, PROCESS FOR PRODUCING SUCH A ROLL, AND PROCESS OF REPAIRING THE ROLL

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Sir:

Transmitted herewith is an election with traverse in the above-captioned application.

___ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
___ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
___ A Request for Extension of Time.
_X_ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 51	51		x 9=	$	x 18=	$0.00
Indep. Claims: 6	6		x 42=	$	x 84=	$0.00
Multiple Dependent Claims Presented			+140=	$	+280=	$0.00
Extension Fees for Month				$		$0.00
			Total:	$	Total:	$0.00

*If less than 20, write 20
**If less than 3, write 3

___ Please charge my Deposit Account No. 19-0089 in the amount of $_____. .

N/A A Check in the amount of $_____ to cover the filing/extension fee is included.

_X_ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.
_X_ Any additional filing fees required under 37 C.F.R. 1.16.
_X_ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136) (a)(3)

Reg. No. 45,294

Neil F. Greenblum
Reg. No. 28,394

As between Groups I and II and I and III, the Examiner asserted that the inventions were related as process of making and product made, and that the inventions are distinct from each other under M.P.E.P. § 806.05(f) because "the core can be inserted into the covering layer rather than applying the covering layer to the core" and that the roll "can be made without heating the covering layer."

As between Groups II and III (note that the Examiner incorrectly indicated Groups II and II) the Examiner asserted that the inventions were unrelated because "[t]he method of making the roll does not require steps of repairing which include heating of covering layer."

As a preliminary matter, Applicant submits that the restriction requirement with regard to groups I and II is improper in as much as there is no apparent distinction between inserting a core into a covering layer and applying a covering layer onto a core, since the term "applying" is clearly broad enough to encompass inserting the core into a covering layer, i.e., an inserting operation is merely one way to "apply" the covering layer onto a roll core. In this regard, Applicant notes that should the Examiner not withdraw the restriction requirement with regard to these two groups, Applicant reserves the right to have the claims of Group II rejoined pursuant to M.P.E.P. Section 821.04, if and when the claims of Group I are found to be allowable.

Applicant further submits that the Examiner has omitted one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. That is, as set forth in M.P.E.P. § 803, "an appropriate explanation" must be

advanced by the Examiner as to the existence of a "serious burden" if the restriction were not required.

In particular, the Examiner has not shown that a concurrent examination of these groups would present a "serious burden" on the Examiner. In fact, while the Examiner has noted that groups II and III on one hand, and group I on the other hand, would be classified in different classes, there is no appropriate statement that the search areas required to examine the invention of Group I would not overlap into the search areas for examining the invention of Group II, Group I would not overlap into the search areas for examining the invention of Group III, and Group II would not overlap into the search areas for examining the invention of Group III. Applicant respectfully submits that the search for the combination of features recited in the claims of the above-noted groups, if not totally co-extensive, would appear to have a very substantial degree of overlap. Because the search for each group of invention is substantially the same, Applicant submit that no undue or serious burden would be presented in concurrently examining Groups I, II and III. Thus, for the above-noted reasons, and consistent with the Office policy set forth above in M.P.E.P. § 803, Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement in this application.

For all of the above reasons, the Examiner's restriction requirement is believed to be improper. Nevertheless, Applicants have elected, with traverse, the invention defined in Group I, in the event that the Examiner chooses not to reconsider and withdraw the

restriction requirement.

Should there be any questions, the Examiner is invited to contact the undersigned at the below listed number.

Respectfully submitted,
DR. Ing Lothar ZIMMERMA

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May 14, 2002
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